

REMARKS

The Office Action dated December 12, 2008 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1-3 and 39-41 have been amended to more particularly point out and distinctly claim the subject matter of the invention. No new matter has been added. Therefore, claims 1-41 are currently pending in the application and are respectfully submitted for consideration.

Claim Rejections Under 35 U.S.C. § 112

The Office Action rejected claims 39-41 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement (i.e. allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention). Specifically, the Office Action alleged that a computer program embodied on a computer-readable medium was not disclosed in the specification. (See Office Action at page 2). This rejection is respectfully traversed for at least the following reasons.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V.*

v. Diamond Automation, Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. Applicants respectfully submit that the specification of the present invention describes “*a computer-readable medium encoded with a computer program, for controlling a processor to implement a method*,” in sufficient detail that one skilled in the art would reasonably conclude that the invention had possession of “*a computer-readable medium encoded with a computer program, for controlling a processor to implement a method*.” Specifically, paragraph 0073 of the specification discloses that an embodiment of the invention is preferably implemented by software, whereby the base station 204 typically comprises a microprocessor, in which the functions according to the method described are implemented as functional software. (See Specification at paragraph 0073, emphasis added). One of ordinary skill in the art would readily understand that, based on the original disclosure, that the inventors had possession of a “*computer program*” and “*computer readable medium*.”

Thus, Applicants respectfully submit that claims 39-41 comply with the written description requirement of 35 U.S.C. § 112, first paragraph. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Claim Rejections Under 35 U.S.C. § 101

The Office Action rejected claims 1-18 under 35 U.S.C. § 101 as allegedly not falling within one of the four statutory categories of invention. Specifically, the Office

Action alleged that claims 1-18 neither transform underlying subject matter, nor are tied to another statutory category that accomplishes the claimed method steps. (See Office Action at pages 2-3).

With respect to claims 1-17, independent claims 1 and 2 have each been amended to clarify that the determining step is performed at a processor, and independent claim 3 has been amended to clarify that the combining step is performed at a processor. Thus, independent claims 1-3 are each tied to a particular apparatus, and thus, fall within one of the four statutory categories of invention, i.e. a process. Furthermore, claims 4-10 depend upon independent claim 1, claims 11-14 depend upon independent claim 2, and claims 15-17 depend upon independent claim 3. Thus, claims 4-17 are also each tied to a particular apparatus, and thus, fall within one of the four statutory categories of invention, i.e. a process. Accordingly, Applicants respectfully submit that the amendment to claims 1-3 effectively moots the rejection, with respect to claims 1-17

With respect to claim 18, Applicants respectfully traverse the rejection. Applicants respectfully point out that claim 18 recites “an apparatus,” and does not recite a series of steps to be performed, as alleged by the Office Action. Accordingly, claim 18 falls within one of the four statutory categories of invention, i.e. a machine.

Accordingly, Applicants respectfully request that the rejection be withdrawn.

The Office Action rejected claims 19-38 under 35 U.S.C. § 101 because the claimed invention allegedly lacks patentable utility. Specifically, the Office Action alleged that there is no utility in generating the limited transmissible signal as claimed in

light of the specification. (See Office Action at page 3). This rejection is respectfully traversed for at least the following reasons.

Under U.S. patent law, an applicant's assertion of utility creates a presumption of utility that will be sufficient to satisfy the utility requirement of 35 U.S.C. § 101. *See e.g. In re Jones*, 628 F.2d 1322, 206 USPQ 885 (C.C.P.A. 1980); *In re Irons*, 340 F.2d 974, 144 USPQ 351 (C.C.P.A. 1965); *In re Langer*, 503 F.2d 1380, 183 USPQ 288 (C.C.P.A. 1974); *In re Sichert*, 566 F.2d 1154, 1159, 196 USPQ 209, 212-213 (C.C.P.A. 1977).

Applicants respectfully submit that the specification contains an assertion of utility. Specifically, the specification explicitly states that when the Peak-to-Average Ratio of a transmissible signal is high, an input signal of an amplifier must be scaled to a lower power or amplitude level in order to fulfill spectrum requirements of a data transmission system in use. (See Specification at paragraph 0002). The specification further states that certain embodiments of the claimed invention provide several advantages. For example, according to an embodiment of the invention, the method of generating a limited transmissible signal allows the reduction of a Peak-to-Average ratio. Furthermore, according to the embodiment of the invention, since the limited transmissible signal is filtered using the pulse shaping filter, the spread of the signal spectrum to other bands caused by limiting the power or amplitude values will be compensated. Finally, according to the embodiment of the invention, since the need to limit the signal is determined from a signal filtered using the pulse shaping filter, the

limitation of the signal becomes more efficient than if the limitation need was determined from a non-filtered signal. (See Specification at paragraph 0012).

Thus, Applicants respectfully submit that the assertion of utility in the specification of the present application creates a presumption of utility of the claimed invention, and that the Office Action has failed to rebut this presumption. Accordingly, Applicants respectfully submit that claims 19-38 satisfy the utility requirement of 35 U.S.C. § 101, and respectfully request that the rejection be withdrawn.

The Office Action rejected claims 39-41 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter (while the Office Action actually uses the term “statutory matter,” Applicants assume that the term “non-statutory subject matter” was intended). It appears that the Office Action objected to the preamble “A computer program, embodied on a computer-readable medium,” and suggested replacing the preamble with “A computer-readable medium encoded with a computer program,” and “A computer-readable medium having stored thereon instructions for.”

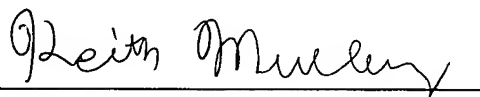
Applicants respectfully submit that there is no requirement, under U.S. patent law, as to the format of the preamble of a software claim. Nevertheless, claims 39-41 have been amended to recite “A computer-readable medium encoded with a computer program,” as the Office Action has suggested. Applicants respectfully submit that the amendment effectively moots the rejection. Accordingly, Applicants respectfully request that the rejection be withdrawn.

For at least the reasons discussed above, Applicants respectfully submit that all of claims 1-41 recite allowable subject matter. It is therefore respectfully requested that all of claims 1-41 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicants undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



Keith M. Mullervy
Registration No. 62,382

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Vienna, Virginia 22182-6212
Telephone: 703-720-7800
Fax: 703-720-7802

KMM:sew